REMARKS

Claim Rejections – 35 U.S.C. § 103

Claims 1-33 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Conboy, *et al.* (U.S. Patent No. 6,363,418) (hereafter 'Conboy') in view of Khosla, *et al.* (U.S. Patent No. 6,202,061) (hereafter 'Khosla') and further in view of Parulski, *et al.* (U.S. Publication No. 2004/0201752) (hereafter 'Parulski'). To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As shown below in more detail, the proposed combination of Conboy, Khosla, and Parulski cannot establish a prima facie case of obviousness because the proposed combination does not teach or suggest each and every element of the claims of the present application

Khosla Neither Discloses Nor Suggests An Image Group Identifier Identifying A Plurality Of Images

The Office Action takes the position that Khosla at column 1, line 65 – column 2, line 15, column 6, lines 15-30, and column 9, lines 25-55, discloses the following portion of the first element of claim 1: an image group identifier identifying a plurality of images. Applicants respectfully note in response, however, that what Khosla at column 1, line 65 – column 2, line 15, in fact discloses is:

> The present invention discloses methods and apparatuses for creating a collection of digital media in a digital processing system. A method in one example of the invention defines search parameters, such as at least one search parameter. Using the search parameter, the digital processing system searches through parameters for a first plurality of digital media to obtain a second plurality of digital media which may be a subset of the first plurality of digital media. Then the digital processing system generates automatically after the search a media container for the second plurality of digital media.

> In one particular embodiment of the present invention, the digital media are digital pictures and the media container is a picture album. The computer user may select the search criteria and then have the computer system automatically search through a picture database to provide the digital pictures which match the search parameters.

In addition, what Khosla at column 6, lines 15-30, in fact discloses is:

> In step 265, the album authoring software determines the set of album pages based upon the selected layout. Further, the album authoring software assigns a unique number to each slot on the ordered set of album pages. Then in step 267, the album authoring software assigns the ordered list of pictures to the numbered slots on the album pages. For example, picture 1 in the ordered list of pictures is placed into slot 1 which would typically be on page 1 of the album. Picture 2 in the ordered list of pictures is placed into slot 2 which may be on page 1 of the album or on page 2 of the album. This assignment is performed for all pictures in the ordered list of pictures currently selected by the user for this particular album. In step 269, the album authoring software scales each picture if necessary to cause it to fit into the corresponding slot on the album page.

And, what Khosla at column 9, lines 22-55, actually discloses is:

> The file system and operating system element 703 includes the original, higher resolution media objects 1 and 2 shown as elements 711 and 713. These elements are the actual digital (or other) data of the media object stored on the computer readable medium under control of the file or storage system such as a disk operating system. The file or storage system also stores properties which are the file system's properties for the media object, such as properties 712 and 714. These properties typically include the file's size for each media object as well as the date of creation, the date of last modification and the type of document. The album publishing/sharing software 705 includes a signature generator and comparator module which is responsible for generating representations or signatures of the media objects and to compare signatures or representations in accordance with the present invention. The web album publishing interface 719 performs functions relating to decoding information with respect to the albums and generating albums as a result of decoding the information specifying album format. The interface to web server system 721 is an optional software module which is used to allow the server computer system 111 to interface with the web server 109. Typically, some services are required in order to interface between the album publishing and sharing software and the software required for

> providing web server functionality. The interface to the dedicated database element 723 provides for database searching and editing of the dedicated database 707.

That is, Khosla at column 1, line 65- column 2, line 15, discloses searching for a first plurality of digital media to obtain a second plurality of digital media, and generating, after a search, a media container for the second plurality of digital media. Khosla's searching for a first plurality of digital media to obtain a second plurality of digital media, and generating, after a search, a media container for the second plurality of digital media does not disclose or suggest an image group identifier as claimed here. An image group identifier as claimed here identifies a plurality of images. Khosla does not disclose or suggest any identifier that identifies a plurality of images but instead discloses a search for a plurality of images. Khosla's media container is a place to collect digital media but does not disclose or suggest an image group identifier identifying a plurality of images as claimed in the present application.

In addition, what Khosla at column 6, lines 15-30, actually discloses is album authoring software that assigns an ordered list of pictures to numbered slots on album pages. Album authoring software that assigns an ordered list of pictures to numbered slots on album pages does not disclose or suggest an image group identifier identifying a plurality of images as claimed here. In fact, Khosla at column 6, lines 21-25, teaches placing individual pictures into individual slots on the album pages. An image group identifier as claimed in the present application, however, identifies a plurality of images. That is, Khosla is concerned with placing an individual picture while the image group identifier as claimed in the present application identifies a plurality of images.

In addition, what Khosla at column 9, lines 22-55, actually discloses is a file or storage system that stores properties which are the file system's properties for a media object. Khosla at column 9, lines 35-37, discloses that the file system's properties for a media object typically include the file's size for each media object as well as the date of creation, the date of last modification and the type of document. That is, Khosla's file system's properties describe the properties of a media object. Khosla's file system's

properties then do not identify a plurality of images as claimed in the present application. Because Khosla's file system's properties do not identify a plurality of images Khosla's file system's properties do not disclose or suggest an image group identifier identifying a plurality of images as claimed in the present application. Khosla does not disclose, suggest, or even mention, at these reference points or anywhere else, anything even remotely resembling an image group identifier identifying a plurality of images as claimed in the present application. Khosla does not disclose or suggest therefore the cited portion of the first element of claim 1. Because Khosla does not disclose or suggest the cited portion of the first element of claim 1 of the present application the Office Action cannot establish a prima facie case of obviousness. The rejections of claims 1-33 should be withdrawn, and the claims should be allowed.

Conboy Neither Discloses Nor Suggests Receiving A Data Stream, The Data Stream Comprising A Document Structured By Markup Elements Having Attributes

The Office Action takes the position that Conboy at column 2, lines 10-30, discloses the following portion of the first element of claim 1: receiving a data stream, the data stream comprising a document structured by markup elements having attributes. Applicants respectfully note in response, however, that what Conboy at column 2, lines 10-30, in fact discloses is:

> Therefore, currently, there is a need for a simple and efficient method to perform on-line image caching control for efficient image display using a hypertext language.
>
> SUMMARY OF THE INVENTION
>
> The present invention is a method for on-line controlling caching of an image on a viewing device to efficiently display the image on the viewing device. The method comprises the following steps: (a) sending from a server to the viewing device an image tag included in a hypertext language code, the image tag having attributes, the attributes specifying the image; (b) parsing the hypertext language code including the image tag; (c) searching for a copy of the image in a cache memory of the viewing device using the image tag attributes; (d) displaying the copy of the image

> if the copy of the image is found in the cache memory and is current; (e) fetching the image from the server if the copy of the image is not found in the cache memory or if the copy of the image is not current; and (f) storing the fetched image and the image tag attributes in the cache memory.

That is, Conboy at column 2, lines 10-30, discloses sending from a server to a viewing device an image tag included in a hypertext language code, the image tag having attributes that specify an image. Conboy's sending from a server to a viewing device an image tag included in a hypertext language code, the image tag having attributes that specify an image does not disclose or suggest receiving a data stream, the data stream comprising a document structured by markup elements having attributes as claimed in the present application. The data stream as claimed in the present application comprises a document structured by markup elements having attributes *and* an image group identifier identifying a plurality of images. Because neither Khosla nor Conboy, alone or in combination, discloses or suggests an image group identifier identifying a plurality of images, Conboy cannot disclose or suggest a data stream that comprises an image group identifier and a document structured by markup elements having attributes as claimed here. Conboy's sending from a server to the viewing device an image tag included in a hypertext language code, the image tag having attributes that specify an image does not disclose or suggest therefore, receiving a data stream, the data stream comprising a document structured by markup elements having attributes and an image group identifier identifying a plurality of images as claimed in the present application. The Office Action therefore cannot establish a prima facie case of obviousness. The rejections of claims 1-33 should be withdrawn, and the claims should be allowed.

Paruslki Neither Discloses Nor Suggests In Response To Receiving The Image Group Identifier

The Office Action takes the position that Paruslki at page 8, paragraph 0088, discloses the following portion of the second element of claim 1: receiving the image group identifier. Applicants respectfully note in response, however, that what Paruslki at page 8, paragraph 0088, in fact discloses is:

> [0088] In block 128 of FIG. 3, the user selects a display mode, and the appropriate transferred images are displayed. The user can select a display of "all images", a display of "all favorite" images, or a display of a "selected group" of images. If the user selects the "display all" option, in block 130 the CPU motherboard 12 in the home computer 10 builds a request to retrieve all of the thumbnail images from the general assets table 600 in FIG. 8. In block 132 all of the image objects are retrieved, which includes the "favlevel" favorites level metadata 666. In block 134 all of the images are displayed in a way that organizes them into groups, with icons indicating the favorite images in the collection of images.

That is, Parulski at paragraph 0088, discloses a request to retrieve a selected group of images, such as "all images," "all favorite" images, or another selected group. Parulski's request to retrieve a selected group of images does not disclose receiving the image group identifier as claimed in the present application. To receive an image group identifier as claimed in the present application, a data stream comprising an image group identifier must be received. That is, a data stream as claimed in the present application comprises an image group identifier. As explained in detail above, neither Conboy nor Khosla, either alone or in combination, discloses or suggests receiving a data stream comprising an image group identifier. Parulski therefore cannot disclose or suggest receiving the image group identifier because an image group identifier is received only when a data stream comprising an image group identifier is received. The request to retrieve a selected group of images of Parulski therefore neither discloses nor suggests receiving an image group identifier as claimed in the present application. The Office Action therefore cannot establish a prima facie case of obviousness. The rejections of claims 1-33 should be withdrawn, and the claims should be allowed.

Conboy Neither Discloses Nor Suggests Retrieving The Images, From The Data Processing System

The Office Action takes the position that Conboy at column 2, lines 10-30, discloses the following portion of the second element of claim 1: retrieving the images, from the data processing system. Applicants respectfully note in response, however, that what Conboy at column 2, lines 10-30, quoted above, in fact discloses is fetching the image from the server if the copy of the image is not found in the cache memory or if the copy of the

image is not current. Conboy's fetching the image from the server if the copy of the image is not found in the cache memory or if the copy of the image is not current does not disclose retrieving the images, from the data processing system as claimed in the present application. Retrieving the images, from the data processing system as claimed in the present application is carried out in response to receiving the image group identifier as claimed in the present application. Neither Conboy, Parulski, nor Khosla, either alone or in combination, discloses or suggests receiving an image group identifier as claimed in the present application. Because the cited references do not disclose receiving an image group identifier as claimed in the present application Conboy cannot disclose retrieving the images, from the data processing system where retrieving the images occurs in response to receiving the image group identifier as claimed in the present application. Conboy's fetching the image from the server if the copy of the image is not found in the cache memory or if the copy of the image is not current therefore neither discloses nor suggests retrieving the images, from the data processing system as claimed in the present application. The Office Action therefore cannot establish a prima facie case of obviousness. The rejections of claims 1-33 should be withdrawn, and the claims should be allowed.

Parulski Neither Discloses Nor Suggests Storing Images On A Server

The Office Action takes the position that Parulski at page 8, paragraph 0088, discloses the following portion of the first element of claim 7: storing images on a server. Applicants respectfully note in response, however, that what Parulski at paragraph 0088, quoted above, in fact discloses is a request to retrieve a selected group of images, such as "all images," "all favorite" images, or another selected group. Parulski's request to retrieve a selected group of images, such as "all images," "all favorite" images, or another selected group does not disclose or suggest storing images on a server as claimed in the present application. Storing images on a server as claimed in the present application includes associating each image with a least one group of images by an image group identifier. The Office Action argues that Khosla discloses an image group identifier as claimed here. As explained above in detail, Khosla does not disclose or

suggest an image group identifier as claimed in the present application. Because Khosla does not disclose an image group identifier, and storing images on a server as claimed in the present application includes associating each image with at least one group of images identified by an image group identifier, Parulski cannot disclose or suggest storing images on a server as claimed in the present application. Because Parulski does not disclose or suggest the cited portion of the first element of claim 7 of the present application the Office Action cannot establish a prima facie case of obviousness. The rejections of claims 1-33 should be withdrawn, and the claims should be allowed.

Conboy Neither Discloses Nor Suggests The Image Identifier Derived From An Attribute Of A Markup Element Of A Document On The Client

The Office Action takes the position that Conboy at column 2, lines 10-30, discloses the following portion of the second element of claim 7: the image identifier derived from an attribute of a markup element of a document on the client. What Conboy actually discloses at column 2, lines 10-30, quoted above, is sending from a server to a viewing device an image tag included in a hypertext language code, the image tag having attributes that specify an image. Applicants submit, however, that the 'image identifier,' read with proper antecedent basis, as claimed here, is an 'image group identifier,' and Conboy's image tag included in a hypertext language code, the image tag having attributes that specify an image does not teach or suggest an image group identifier as claimed here. It cannot be said then that Conboy discloses or suggests an image identifier derived from an attribute of a markup element of a document on the client as claimed in the present application where the image identifier is an image group identifier. Because Conboy does not disclose or suggest the image identifier derived from an attribute of a markup element of a document on the client, the Office Action cannot establish a prima facie case of obviousness. The rejections of claims 1-33 should be withdrawn, and the claims should be allowed.

Relations Among Claims

Independent claim 1 claims method aspects of distributing images in a data processing system according to embodiments of the present invention. Independent claims 12 and 23 respectively claim system and computer program product aspects of distributing images in a data processing system according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 12 and 23 are allowable because claim 1 is allowable. The rejections of claims 12 and 23 therefore should be withdrawn, and claims 12 and 23 should be allowed.

Claims 2-6, 13-17, and 24-28 depend respectively from independent claims 1, 12, and 23. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Conboy, Khosla, and Parulski does not disclose or suggest each and every element of the independent claims, so also the combination of Conboy, Khosla, and Parulski cannot possibly disclose or suggest each and every element of any dependent claim. The rejections of Claims 2-6, 13-17, and 24-28 therefore should be withdrawn, and these claims also should be allowed.

Independent claim 7 claims method aspects of distributing images in a data processing system according to embodiments of the present invention. Independent claims 18 and 29 respectively claim system and computer program product aspects of distributing images in a data processing system according to embodiments of the present invention. Claim 7 is allowable for the reasons set forth above. Claims 18 and 29 are allowable because claim 7 is allowable. The rejections of claims 18 and 29 therefore should be withdrawn, and claims 18 and 29 should be allowed.

Claims 8-11, 19-22, and 30-33 depend respectively from independent claims 7, 18, and 29. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Conboy, Khosla, and Parulski does not disclose or suggest each and every element of the independent claims, so also the combination of Conboy, Khosla, and Parulski cannot possibly disclose or suggest each

and every element of any dependent claim. The rejections of Claims 8-11, 19-22, and 30-33 therefore should be withdrawn, and these claims also should be allowed.

Conclusion

Claims 1-33 stand rejected under 35 U.S.C § 103 as obvious over Conboy in view of Khosla and in further view of Parulski. The combination of Conboy, Khosla, and Parulski does not teach or suggest each and every element of Applicants' claims. Claims 1-33 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-33.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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